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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,142	06/27/2003	David Hung	005284.00196	5158

38732 7590 07/22/2004

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EXAMINER
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KENNEDY, SHARON E

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/607,142	<b>Applicant(s)</b> HUNG ET AL.	
	<b>Examiner</b> Sharon Kennedy	<b>Art Unit</b> 3762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-37 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06262003</u> . | 6) <input type="checkbox"/> Other: ____  |

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### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

#### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because it identifies the wrong serial number.

#### ***Specification***

The disclosure is objected to because of the following informalities: Please re-update the specification, "Related Applications" section, to include the new patent number. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

Claims 18-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Jeter et al., US 5,683,420. Note Jeter access probes 3. The instructions are not accorded patentable weight as set forth by *In re Ngai et al.*, CAFC 03-1524, May 13, 2004. Accordingly, the claims merely require an apparatus having the ductal access probes, which is shown by Jeter. Note Jeter manifold 14 and flexible bags S which anticipate the claimed receptacles. As regards claims 27 etc., see Jeter rubber sheet tab 23, described in column 5, which individually cover access holes 18a. As regards the collection tube, note Jeter syringe 16. Jeter syringe plunger anticipates the claimed fluid control device attached to the collection tube.

***Double Patenting***

Claims 18-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 51 of copending Application No. 09/907,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only by the instructions set forth in the kit. Since the instructions are accorded no patentable weight since they are printed matter, the claims conflict. As set forth by *In re Ngai et al.*, a known product cannot be re-patented by simply attaching a set of instructions to that product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 18-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-29 (withdrawn from prosecution) of copending Application No. 09/565,642. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only by the instructions set forth in the kit. Since the instructions are accorded no patentable weight since they are printed matter, the claims conflict. As set forth by *In re Ngai et al.*, a known product cannot be re-patented by simply attaching a set of instructions to that product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The examiner notes that these claims are withdrawn from prosecution, however, the double patenting rejection must be applied until those claims are canceled.

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Claims 18-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-42 of U.S. Patent No. 6,398,765. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is directed to the kit having the collection device.

Claims 18-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,629,936. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is directed to the kit having the collection device. The instructions differ; however, these are accorded no patentable weight since they are printed matter. As set forth by *In re Ngai et al.*, a known product cannot be re-patented by simply attaching a set of instructions to that product.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is 703/305-0154. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703/308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

  
Sharon Kennedy  
Primary Examiner  
Art Unit 3762

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